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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/557,481	11/21/2005	Michael Heckmeier	MERCK-3091	2161
23599 7590 05/24/2007 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			EXAMINER WU, SHEAN CHIU	
			ART UNIT 1756	PAPER NUMBER
			MAIL DATE 05/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/557,481

Applicant(s)

HECKMEIER ET AL.

Examiner

Shean C. Wu

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/21/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claim 12 provides for the use of liquid-crystalline medium, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

### ***Claim Rejections - 35 USC § 103***

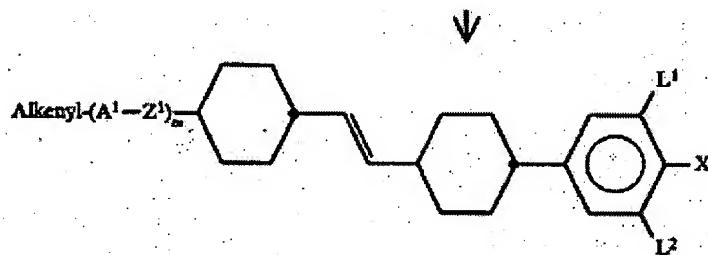
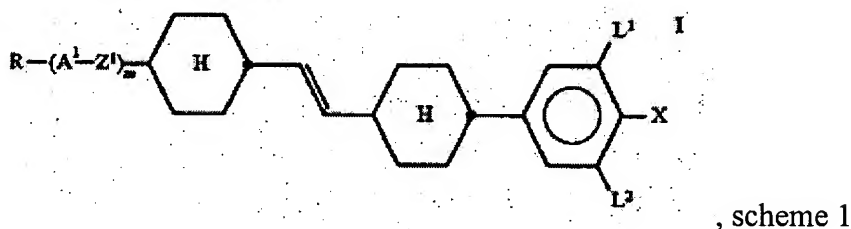
Art Unit: 1756

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

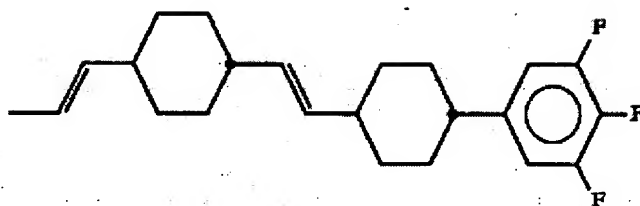
4. Claims 1-4, 6-9 and 11-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bartmann et al. (US 5,679,285).

The reference discloses a liquid crystal media as above are used for electro-optical applications. The reference media provide new, stable LC or mesogenic compounds represented by formula I with relatively low viscosity and high dielectric anisotropy, low viscosity, thermal and UV stability. See the formulae below:



and scheme 4

Art Unit: 1756



The other suitable compounds are shown from col. 12 to col. 19. The reference Examples 10 and 11 anticipate the claimed invention.

### Example 10

PCH-3	20.00%	Clearing point [°C.]: 103.3
K6	6.40%	$\Delta\epsilon$ (1 kHz, 20° C.): +9.8
K9	7.20%	$V_{(10,0,20)}$ [V]: 1.18
CCP-20CF <sub>3</sub>	4.00%	
CCP-30CF <sub>3</sub>	4.00%	
CCP-40CF <sub>3</sub>	4.00%	
CCP-50CF <sub>3</sub>	4.00%	
ECCP-20CF <sub>3</sub>	4.00%	
ECCP-30CF <sub>3</sub>	4.00%	
ECCP-50CF <sub>3</sub>	4.00%	
ECCP-3F	4.00%	
ECCP-5F	4.00%	
CBC-33F	4.00%	
CBC-53F	3.20%	
CBC-55F	3.20%	
CVCG-V-F	20.00%	

### Example 11

PCH-3	20.00%	Clearing point [°C.]: 99.5
K6	6.40%	$\Delta\epsilon$ (1 kHz, 20° C.): +10.7
K9	7.20%	$V_{(10,0,20)}$ [V]: 1.18
CCP-20CF <sub>3</sub>	4.00%	
CCP-30CF <sub>3</sub>	4.00%	
CCP-40CF <sub>3</sub>	4.00%	
CCP-50CF <sub>3</sub>	4.00%	
ECCP-20CF <sub>3</sub>	4.00%	
ECCP-30CF <sub>3</sub>	4.00%	
ECCP-50CF <sub>3</sub>	4.00%	
ECCP-3F	4.00%	
ECCP-5F	4.00%	
CBC-33F	4.00%	
CBC-53F	3.20%	
CBC-55F	3.20%	
CVCG-V-F	20.00%	

Art Unit: 1756

The reference compounds PCH-3, CCP-n-CF<sub>3</sub>, ECCP and CVCG-V-F read on the present formulae Z-8, IIc, VI and I-5, respectively. The reference anticipates the claimed invention. Also, see Examples 5-7, which the concentration ranges of the reference compounds anticipate the present claim 6.

With respect to claims 8, if not anticipated, it would have been obvious to those skilled in the art to follow the guidelines of the reference teaching by limiting the formula II to two rings (r=0) as the present formula II to arrive at the claimed invention.

5. Claims 1, 3-9 and 11-13 are rejected under 35 U.S.C. 102(b)/(e) as anticipated by Yanai et al. (US 2002/0066887 or US 6,572,938).

The reference discloses a liquid crystal composition having a high upper limit temperature of a nematic phase, a low lower limit temperature of the nematic phase and a small birefringence. The liquid crystal composition is useful for an AM-LCD device. Liquid crystal compositions are disclosed which comprise a component I comprising at least one compound selected from the group of compounds represented by formula (I-1) or (I-2), a component II comprising at least one compound selected from the group of compounds represented by formulae (II-1) to (II-8) and a component III comprising at least one compound selected from the group of compounds represented by formulae (III-1) to (III-5) as described in the specification (see pages 1 and 2). The Example 15 comprises the compounds below:

Art Unit: 1756

3-HEH-3	3.0%
4-HEH-3	3.0%
3-HHEH-3	3.0%
V-HHEH-3	3.0%
<u>Component II</u>	
7-HB-F	4.0%
5-HB-CL	8.0%
3-HEB-F	5.0%
3-HHB-F	5.0%
V-HHB-F	5.0%
3-HVHB (F)-F	5.0%
3-HHB (F, F)-F	8.0%
5-HHB (F, F)-F	3.0%
3-HHEB-F	5.0%
3-HHEB (F)-F	5.0%
3-HHCF2OB (F, F)-F	12.0%
5-HHCF2OB (F, F)-F	12.0%
<u>Component III</u>	
3-HH-4	5.0%
2-HH-EMe	3.0%
3-HH-EMe	3.0%

The compound of 3-HVHB(F)-F reads on the present formula I-5 (claims 1 and 3); the compounds of 3-HHB-F, V-HHB-F, 3-HHB(F,F)-F and 5-HHB(F,F)-F read on the present formulae II and IIc (claims 6 and 9); the compounds of 3-HHCF2OB(F,F)-F and 5-HHCF2O(F,F)-F read on the present formula Q-6 (claim 5); the compounds of 7-HB-F and 5-HB-CL read on the present formulae K1 and K10 (claim 8); and the compound of 3-HH-4 reads on the present formula Z-1 (claim 4). The concentration range of the reference also reads on the present claim 7. The reference clearly anticipates the claimed invention.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartmann et al. (US 5,679,285) or Yanai et al. (US 2002/0066887 or US 6,572,938) as applied to claims above, and further in view of Heckmeier et al. (US 2002/0003226 or US 6,592,951).

The references (US '285 and US '938) differ from the present claim in that the claim has additional one or more compounds of formulae O1 and O2. The present

Art Unit: 1756

compounds of O1 and O2 are known in the art (see formula Xe on col. 19 and compounds of CCOC-n-m in Examples G and H of US '951) and used in the liquid-crystalline medium based on a mixture of polar compounds having positive dielectric anisotropy, therefore, it would have been obvious to those skilled in the art to add these known compounds of US '951 into the references (US '285 or '938) to arrive at the claimed invention.

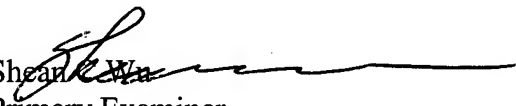
7. Please provide the references 35-37 cited in PTOS/SB/08A(11/21/05).
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shean C. Wu whose telephone number is 571-272-1393. The examiner can normally be reached on 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1756

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Shear  
Primary Examiner  
Art Unit 1756

SCW